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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,567	01/23/2001	Shinobu Ichikura	1614.1114/HEW	2348

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EXAMINER	
SCHLAIFER, JONATHAN D	
ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/766,567	ICHIKURA, SHINOBU	
	Examin r	Art Unit	
	Jonathan D. Schlaifer	2178	

-- The MAILING DATE of this communication appears on the cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *6/22/01* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to an amendment to application 09/766,567, filed on 10/6/2004.
2. Claims 1-19 are pending in the case. Claims 1, 8, 12-14, 19 are independent claims.
3. The objection to the specification is withdrawn as necessitated by amendment.
4. The objection to claim 2 is withdrawn as necessitated by amendment.
5. All rejections previously issued under 35 U.S.C. 102 are withdrawn as necessitated by amendment.
6. All rejections previously issued under 35 U.S.C. 103 are withdrawn as necessitated by amendment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1, 8, 12-14 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Montalbano et al. (EPO 0833258A2—publication date 1/4/1998), hereinafter Montalbano.**
8. **Regarding independent claim 1,** Montalbano discloses an information processing apparatus having a book mark registration function (in the Abstract, lines 1-4, it is a system to provide a multimedia bookmark) for a user to register a home page (in the Abstract, lines 1-4, the bookmarks are for HTML files, which home pages are) which is being inspected by the user (in the Abstract, line 4, a user is accessing the Web page),

comprising: a keyword extracting section configured to automatically analyze contents of a registering home page to thereby identify and extract keywords from the contents of the registering home page which is to be registered (in the Abstract, lines 4-8, there is a portion of the system which scans the page for key words); and a title adding section configured to automatically create a new title of the registering home page from the extracted keywords (in the Abstract, this process occurs in lines 5-12; note that even though the MBD file existed before, it is a new title because it was not previously considered a title before), and configured to automatically add the title to the user's bookmark registration of the registering home page (in the Abstract, this process occurs in lines 5-12, as the new title is added).

9. **Regarding independent claim 8,** it is a computer-readable storage medium that encodes a program with the functionality of the apparatus of claim 1 (storage media are inherently volatile or non-volatile) and is rejected under the same rationale.
10. **Regarding independent claim 12,** it is an apparatus that is a more broadly claimed version of claim 1, and is rejected under the same rationale as claim 1.
11. **Regarding independent claim 13,** it is an computer-readable storage medium that is a more broadly claimed version of claim 8, and is rejected under the same rationale as claim 8.
12. **Regarding independent claim 14,** it is a method that is performed by the apparatus of claim 12, and is rejected under the same rationale.
13. **Regarding independent claim 18,** it is a method that is a more broadly claimed version of claim 14, and is rejected under the same rationale.

14. **Regarding independent claim 19,** Montalbano discloses a method of registering bookmarks at a user terminal used to select, load, and display pages (see lines 1-10 in the Abstract, Montalbano's invention involves a browser which registers bookmarks, which inherently involves a terminal), the method comprising: at the user terminal, selecting a page by a user, in response downloading the page from a server to the terminal and in response displaying he page on the terminal (see lines 1-5 of the Abstract, this is how the browser operates), where the page comprises content (see lines 1-5 of the Abstract, since the page is HTML it must necessarily comprise content); at the user terminal, receiving a command from the user to bookmark the page (see line 5 of the Abstract, the user makes a bookmarking request); based on the command, at the user terminal automatically extracting keywords from the contents of the page and using the keywords to create a new bookmark registration for the page (see lines 4-12 of the Abstract, the keyword data is extracted and used to generate a new title).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. **Claims 2, 9, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montalbano, further in view of Bates et al. (USPN 6,184,886 B1—filing date 9/4/1998), hereinafter Bates.**

16. **Regarding dependent claim 2,** Montalbano fails to disclose an apparatus further comprising an image creating section configured to create a thumbnail of a display image of the registering home page in its entirety. However, Bates, in col. 5, lines 66-67 and col. 6, lines 1-24, describes a browser that displays thumbnails of the constituent pages in order to make it easier for the user to navigate. It would have been obvious to one of ordinary skill in the art at the time of the invention to add Bates' thumbnail capacity to Montalbano's invention in order to make it easier for the user to navigate.

17. **Regarding dependent claim 9,** it is a computer-readable storage medium that encodes a program with the functionality of the apparatus of claim 2 and is rejected under the same rationale.

18. **Regarding dependent claim 15,** it is the method performed by the apparatus of claim 2 and is rejected under similar rationale.

19. **Claim 3, 10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montalbano, further in view of Li et al. (USPN 6,631,496 B1—filing date 3/22/1999), hereinafter Li.**

20. **Regarding dependent claim 3,** Montalbano fails to disclose an apparatus further comprising a summarizing section configured to automatically create a summary of the contents of the registering home page from the contents of the registering home page. However, Li, in col. 13, lines 12-34 discloses that a summary is part of the metadata associated with a bookmarking system in order to aid the user in discriminating between bookmarks. It would have been obvious to one of ordinary skill in the art at the time of

the invention to add Li's summary capacity to Peercy's invention in order to make it easier for the user to discriminate between bookmarks.

21. **Regarding dependent claim 10,** it is a computer-readable storage medium that encodes a program with the functionality of the apparatus of claim 3 and is rejected under the same rationale.

22. **Regarding dependent claim 16,** it is the method performed by the apparatus of claim 3 and is rejected under similar rationale.

23. **Claims 4, 11, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montalbano, further in view of Sweet et al. (USPN 6,415,278 B1—filing date 11/14/1997), hereinafter Sweet.**

24. **Regarding dependent claim 4,** Peercy fails to disclose an apparatus further comprising a list creating section configured to create a list of URLs of linking destinations included in the registering home page. However, Sweet compiles a list of URLs that emanate from a given page in col. 10 lines 1-7 for use in validity checking of the links. It would have been obvious to one of ordinary skill in the art at the time of the invention to compile a list of URLs as in Sweet and integrate it into Montalbano's invention in order provide Montalbano's invention with access to a list of links with validity checking.

25. **Regarding dependent claim 11,** it is a computer-readable storage medium that encodes a program with the functionality of the apparatus of claim 2 and is rejected under the same rationale.

26. **Regarding dependent claim 17,** it is the method performed by the apparatus of claim 4 and is rejected under similar rationale.

27. **Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montalbano, further in view of Cheng et al. (USPN 6,211,878 B1—filing date 11/16/1998), hereinafter Cheng.**

28. **Regarding dependent claim 5,** Montalbano fails to disclose an apparatus further comprising a page analyzing section configured to analyze an inspection record of home pages to obtain an analyzed result, and to output information of a home page which is being inspected with a display order or display format dependent on the analyzed result. However, Cheng, in col. 10, lines 39-62, discloses how an MVC design pattern is used to analyze and organize web pages in order to help control meaningful components in web pages (see col. 10, lines 47-48). It would have been obvious to one of ordinary skill in the art at the time of the invention to use an MVC design pattern to analyze and organize web pages in the manner of Cheng in Montalbano's invention in order to help control meaningful components in web pages.

29. **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montalbano, further in view of Kurapati et al. (USPN 6,499,029 B1—filing date 3/29/2000), hereinafter Kurapati.**

30. **Regarding dependent claim 6,** Montalbano fails to disclose an apparatus further comprising an HTML creating section configured to create an HTML file and output the HTML file when starting a browser, so as to output a home page having a high inspection frequency with a priority over others based on an inspection record of home pages. However, Kurapati, in col. 16, lines 50-55, describes a methodology wherein search terms are ranked by frequency of use. Since it was notoriously well known in the art at

the time of the invention that HTML files are output in a browser, it would have been obvious to one of ordinary skill in the art at the time of the invention to use Kurapati's ranking by frequency of use in combination with Montalbano's invention because this would have made the most frequently used pages the most accessible.

31. **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montalbano, further in view of Ernst (USPN 6,591,278 B1—filing date 3/3/2000).**

32. **Regarding dependent claim 7,** Montalbano fails to disclose an apparatus further comprising a scrap information storage configured to store an arbitrary specified portion of the registering home page. However, Ernst, in col. 15, lines 66-67 and col. 16, lines 1-31, especially col. 16, lines 25-31, describe the use of a clipboard as a temporary scrap storage area. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a clipboard as in Ernst to store temporary data in Montalbano in order to help the user have a place to temporarily store scrap data.

Response to Arguments

33. Applicant's arguments with respect to claims 1, 8, 12-14 and 18 have been considered but are moot in view of the new ground(s) of rejection.

34. The Examiner respectfully disagrees with the arguments regarding claim 2. The applicant argues that the prior art is insufficient to meet the limitation of generating a thumbnail because a thumbnail is not generated at the proper time. The Examiner argues in response that the art teaches the use of thumbnails to encapsulate a visual summary the general principles present in the art would be sufficient to make obvious the limitations of

the claimed invention because they would be a logical and obvious extension of the teachings of the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 6,100,890 (filing date 11/25/1997)—Bates et al.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is (571) 272-4129. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS

STEPHEN HONG
SUPERVISORY PATENT EXAMINER